

Amendments to the Drawings:

The drawing sheet or sheets attached in connection with the above-identified application containing Figure(s) 1-2c are being presented as a new formal drawing sheet or sheets to be substituted for the previously submitted drawing sheet or sheets. The drawings have not been amended and no new matter has been added.

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-7 and 14-16 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Applicants have amended claims 1-7 and 14-16. After amending the claims as set forth above, claims 1-20 are now pending in this application.

The Examiner issued an Office Action on June 6, 2006 rejecting all of the pending claims and objecting to Figures 1A-2C. Specifically, the Examiner objected to Figures 1a-2c as not being clear; however Applicants respectfully submit that the Figure are as clear as current technology allows and would be readily understood by one of ordinary skill in the art. Regardless, Applicants are submitting herewith replacement figures for Figures 1-2c in accordance with 37 CFR 1.121(d).

The Examiner objected to claim 2 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. In addition, Applicants have amended claim 2 to further limit the scope of its preceding claim.

The Examiner also provisionally rejected claims 1-20 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Pat. App. Ser. No. 10/903514 and over claims 1-20 of copending Pat. App. Ser. No. 10/800292. In response to the double patenting rejection of claims 1-20, Applicants are submitting herewith a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) over both of the cited copending applications.

The Examiner rejected claims 1-20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding the Examiner's contention that the use of the term "about" renders the claims indefinite under §112, Applicants respectfully disagree. Initially, upon reading the specification it would be clear to one skilled in the chemical arts that a degree of imprecision in the claimed compositional ranges is inherent in the present invention. One skilled in the art would be aware of the limitations of the science of non-stoichiometry, the natural propagation of uncertainty, and that a certain degree of approximation is intrinsic to the description of the specified ranges but still enables one skilled in the art to practice the invention. Furthermore, the specification recites the invention in a general tenor and a person skilled in the art, practicing the claimed invention, would not conclude that precisely achieving the limits of the claimed ranges is essential or even beneficial in realizing the objectives of the invention.

Moreover, the use of the term "about" is supported in case law as a proper way to express that a chemical feature is the cited numerical amount with some small latitude for inexactness of amounts which still fulfill the spirit of the invention. An applicant is not required to describe exactly the subject matter claimed but merely must show to one skilled in the art that the inventor possessed the claimed invention at the time of filing. *Union Oil Co. of Cal. v. Atlantic Richfield, Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000). Furthermore, maximum precision is not necessary when the tenor of the disclosure indicates approximation. *Eiselstein v. Frank*, 52 F.3d 1035, 1040 (Fed. Cir. 1995). Addition of the term "about" to a claim to describe a range does not constitute a different invention where the application describes a range and the application conveys to one skilled in the art that the range was intended to be approximate. *Eiselstein*, 52 F.3d at 1039-40.

It is also well established CAFC case law that a claim should be interpreted to allow for use of the term "about" to prevent an infringer from improperly abusing the Patent Law by changing the percentage of the chemical constituent by a small percentage to avoid infringement. See, e.g., *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367 (Fed. Cir. 2001). Words of

approximation such as the term “about” are descriptive terms that may be employed to avoid a strict numerical boundary to the specified parameter. *Ecolab*, 264 F.3d at 1367 citing, *Pall Corp. v. Micron Seps.*, 66 F.3d 1211, 1217 (Fed. Cir. 1995). Furthermore, without broadening terms the precise numerical ranges of a claim do not avoid a strict numerical boundary.

Jeneric/Pentron, Inc. v. Dillon Co., Inc., 205 F.3d 1377, 1381 (Fed. Cir. 2000) citing *Modine Manuf. Co. v. United States Trade Commission*, 75 F.3d 1545, 1554 (Fed. Cir. 1996) and *Pall*, 66 F.3d at 1217.

In summary, one skilled in the chemical arts would recognize that it is unnecessary to achieve absolute precision with respect to the ranges discussed above and that use of the term “about” captures reasonable deviations of the specified ranges that are clearly within the spirit of the invention. The use of the term “about” conveys the broader aspects of the invention to the degree of precision achievable in the art, given the limitation of expression in claim language. Applicants respectfully suggest that this rejection under §112 has been overcome and should be withdrawn.

Turning to the Examiner’s rejection of the claims over the cited prior art, Applicants respectfully disagree with the application of the art to the claims as amended. Applicants have amended independent claims 1 and 14-16 to more particularly define the scope of the claimed invention. In particular, claim 1 has been amended such that the claimed material comprises Li, Ni, Mn, Co, M’, O₂, X, i.e. all are in an amount greater than at least 0. Throughout the specification and drawings, various examples are given wherein such amounts are cited and one of skilled in the art would understand that the invention is operable in certain non-stoichiometric ranges as are cited by the applicants.

Claims 1, 2, and 8-15 stand rejected under 35 U.S.C. §102(b) as anticipated by the Ohzuku publication. Claims 1-4, 6 and 8-15 stand rejected under §102(b) as anticipated by U.S. Pat. App. Pub. No. 2002/0119374 in the name of Yang. Claim 15 stands rejected under §102(b) as anticipated by U.S. Pat. No. 6,040,090 issued to Sunagawa. Claims 16-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over either Ohzuku or Yang in view of U.S. Pat. App.

Pub. No. 2002/0055042 in the name of Kweon. For at least these reasons, Applicant respectfully request s that the rejection be withdrawn and the claims allowed.

Regarding the rejection of claims 1, 2 and 8-15 over Ohzuku, Applicants have amended the claims to clarify that the claimed composition includes an amount of the enumerated elements which is greater than 0. Ohzuku teaches the use of $\text{LiNi}_{1/2}\text{Mn}_{1/2}\text{O}_2$ but fails to teach a composition comprising Li, Ni, Mn, Co, M’O₂, and X where M’=Mg,Zn,Al,Ga,B,Zr,Ti and X=F,S,Cl,I as claimed in the present application. For at least these reasons, Applicant respectfully request s that the rejection be withdrawn and the claims allowed.

Applicants also respectfully disagree with the rejection of claims 1-4, 6, and 8-15 over Yang. The Applicants’ claims as amended require that z (thus F,S,Cl, or I) be greater than 0. Yang fails to teach such composition. Yang does not disclose a composition having a composition comprising Li, Ni, Mn, Co, M’O₂, and X where M’=Mg,Zn,Al,Ga,B,Zr,Ti and X=F,S,Cl,I. For at least these reasons, Applicant respectfully request s that the rejection be withdrawn and the claims allowed.

The rejection of claim 15 over Sungawa is also improper. As with the Ohzuku and Yang references, Sungawa fails to teach the claimed composition. Namely, Sungawa merely teaches a material comprising Li, Ni, Mn, Co, M’ and O₂ not the claimed composition which comprises a either F, S, Cl, or I. For at least these reasons, Applicant respectfully request s that the rejection be withdrawn and the claims allowed.

In regard to the rejection of claims 16-20 over Ohuku or Yang in view of Kweon, Applicants note that the Examiner has provided no reasonable basis why one of ordinary skill would have been motivated to combine the materials taught by Ohzuku or Yang with the teachings of Kweon. While Applicants appreciate the Examiner’s statement that “the motivation for providing an metal oxide coating on the positive active material is that it improves cell energy, cycle life, and thermal stability of the cell”, this broad statement does not illustrate a motivation in any of the prior art for combining the specific teachings in the way the Examiner

has done. In addition, as discussed above, neither Ohuku or Yang disclose the composition as claimed. Kweon does not remedy this deficiency. Kweon merely teaches the use of a positive electrode material, and not the specific material claimed in claims 16-20. For at least these reasons, Applicant respectfully request s that the rejection be withdrawn and the claims allowed.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1450. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1450. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1450.

Respectfully submitted,

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By 

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